



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,682	10/16/2001	Barney Scott Graham	VBLT:003US/SLH	6636

7590 04/20/2004

FULBRIGHT & JAWORSKI L.L.P.  
A REGISTERED LIMITED PARTNERSHIP  
SUITE 2400  
600 CONGRESS AVENUE  
AUSTIN, TX 78701

EXAMINER

JIANG, SHAOJIA A

ART UNIT PAPER NUMBER

1617

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/981,682

Applicant(s)

GRAHAM ET AL.

Examiner

Shaojia A Jiang

Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 26 March 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☒ The proposed amendment(s) will not be entered because:  
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-9, 11 and 13-20 (all).

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
10. ☐ Other: \_\_\_\_\_

  
SHAOJIA ANNA JIANG  
PATENT EXAMINER

***Advisory Action***

This Office Action is a response to Applicant's proposed amendment and response after FINAL filed on March 26, 2004.

2. Applicant's proposed amended claims 1-9, 11 and 13-20 are not deemed to place the application in better form for appeals by materially reducing or simplifying the issues for appeal. More importantly Applicant's proposed amendment does not place the application in conditon for allowance.

5. The rejection of claims 1-8 and 13-18 made under 35 U.S.C. 112, second paragraph, for indefinite expressions for reasons of record stated in the Final Office Action dated October 2, 2003 is maintained.

The rejection of claims 1 and 8 made under 35 U.S.C. 102(b) as being anticipated by Maziere et al. for reasons of record stated in the Final Office Action dated October 2, 2003 is maintained.

The rejection of Claims 1-9, 11, 13, 15-16, and 19-20 made under 35 U.S.C. 103(a) as being unpatentable over Maziere et al. and Park et al. in view of Pastey et al. for reasons of record stated in the Final Office Action dated October 2, 2003 is maintained.

The rejection of Claim 14 made under 35 U.S.C. 103(a) as being unpatentable over Maziere et al. and Park et al. in view of Pastey et al. for reasons of record stated in the Final Office Action dated October 2, 2003 is maintained.

Art Unit: 1617

The rejection of Claim 17 made under 35 U.S.C. 103(a) as being unpatentable over Maziere et al. and Park et al. in view of Pastey et al. and Fisher et al. for reasons of record stated in the Final Office Action dated October 2, 2003 is maintained.

The rejection of Claim 18 made under 35 U.S.C. 103(a) as being unpatentable over Maziere et al. and Park et al. in view of Pastey et al. and Gruber et al. for reasons of record stated in the Final Office Action dated October 2, 2003 is maintained.

Applicant's arguments with respect to all rejections of record in the Final Office Action have been considered but are not found persuasive.

Further, as pointed out in the Final Office Action, Applicant's testing results shown in the Figures 1-11 and Example 2 of the specification herein have been fully considered but are not deemed persuasive as to the nonobviousness and/or unexpected results of the claimed invention over the prior art. Figures 1-11 and Example 2 herein demonstrate only one particular HMG-CoA reductase inhibitor, lovastatin, diminishes a single virus, RSV replication in mice. Thus, the evidence in the working examples is not commensurate in scope with the claimed invention, i.e., any infection by any virus in claim 1 or those viruses recited in claim 8, and does not demonstrate criticality of a claimed range of HMG-CoA reductase inhibitors in the claimed method. See MPEP § 716.02(d). Furthermore, the record contains no evidence of nonobviousness or unexpected results for the combinations recited in claims 14, 17, and 18 over the prior art. Therefore, the evidence presented in specification herein is not seen to be clear and convincing in support the nonobviousness of the instant claimed invention over the prior art.

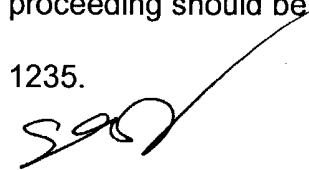
Art Unit: 1617

Note that arguments of counsel cannot take the place of factually supported objective evidence. See, e.g., *In re Huang*, 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is 571.272.0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on 571.272.0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.



S. Anna Jiang, Ph.D.  
Patent Examiner, AU 1617  
April 17, 2004